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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,791	04/05/2001	Lee Harland	PCS10914ADAM	4080

7590

08/21/2003

Gregg C. Benson
Pfizer Inc.
Patent Department, MS 4159, Eastern Point Road
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EXAMINER

CHERNYSHEV, OLGA N

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 08/21/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,791

Applicant(s)

HARLAND, LEE

Examiner

Olga N. Chernyshev

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,22,24-26 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22,24-26 and 33 is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 13, 2003 has been entered.

Response to Amendment

2. Claims 2, 23 and 27-32 have been cancelled and claims 1, 4-6, 24-26 and 33 have been amended as requested in the amendment of Paper No. 14, filed on June 18, 2003. Claims 1, 3-6, 22, 24-26 and 33 are pending in the instant application.

Claims 1, 3-6, 22, 24-26 and 33 are under examination in the instant office action.

3. The Text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Any objection or rejection of record, which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

5. Applicant's arguments filed on June 18, 2003 have been fully considered but they are not deemed to be persuasive for the reasons set forth below.

Sequence compliance

6. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2).

Art Unit: 1646

However, this application fails to comply with the requirements of 37 C.F.R. § 1.821 through 1.825. Specifically, no sequence listing has been provided which includes the sequences presented in Figure 2 of the instant specification. In case these sequences are new, Applicant needs to provide a substitute computer readable form (CRF) copy of a "Sequence Listing" which includes all of the sequences that are present in the instant application and encompassed by these rules, a substitute paper copy of that "Sequence Listing", an amendment directing the entry of that paper copy into the specification, and a statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. §§ 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d). The instant specification will also need to be amended so that it complies with 37 C.F.R. § 1.821(d) which requires a reference to a particular sequence identifier (SEQ ID NO:) be made in the specification and claims wherever a reference is made to that sequence. For rules interpretation Applicant may call (703) 308-1123. See M.P.E.P. 2422.04.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1 and 3-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

Art Unit: 1646

art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 3-6 are directed to polynucleotides which have 95% identity to polynucleotides having SEQ ID NO: 1 or SEQ ID NO: 5 or to polynucleotides encoding polypeptides of SEQ ID NO: 2 or SEQ ID NO: 6 or to a cDNA contained in an ATCC Deposit. However, the instant specification fails to describe the entire genus of nucleic acids, which are encompassed by these claims. In making a determination of whether the application complies with the written description requirement of 35 U.S.C. 112, first paragraph, it is necessary to understand what Applicant has possession of and what Applicant is claiming. From the specification, it is clear that Applicant has possession of nucleic acid molecules which encode proteins which have the amino acid sequences of SEQ ID NO: 2 and SEQ ID NO: 6. This nucleic acid molecules have nucleic acid sequence of SEQ ID NO: 1 and of SEQ ID NO: 5 and cDNA is contained within ATCC deposit. The subject matter, which is claimed is described above. First, a determination of the level of predictability in the art must be made in that whether the level of skill in the art leads to a predictability of structure; and/or whether teachings in the application or prior art lead to a predictability of structure. The claims are polynucleotides which have 95% identity to polynucleotides having SEQ ID NO: 1 or SEQ ID NO: 5 or to polynucleotides encoding polypeptides of SEQ ID NO: 2 or SEQ ID NO: 6 or to a cDNA contained in an ATCC Deposit. First, the claims are not limited to a polynucleotide with a specific nucleic acid sequence. The claims only require the polynucleotide to share some degree of structural similarity to the isolated polynucleotides of SEQ ID NO: 1 and 5. The specification only describes polynucleotides having the nucleic acid sequence of SEQ ID NO: 1 and SEQ ID

Art Unit: 1646

NO: 5 and fails to teach or describe any other polynucleotide which lacks these nucleic acid structure and encodes a proteins with a specific recited function. Therefore, there is a lack of guidance or teaching regarding structure and function because there is only one example provided in the specification and because there is no guidance found in the prior art.

Next in making a determination of whether the application complies with the written description requirement of 35 U.S.C. 112, first paragraph, each claimed species and genus must be evaluated to determine whether there is sufficient written description to inform a skilled artisan that applicant was in possession of the claimed invention at the time the application was filed. With this regard, the instant application fails to provide a written description of the species or the genus which are encompassed by the instant claims except for the polynucleotides of SEQ ID NO: 1 and SEQ ID NO: 5. The specification does not provide a complete structure of those polynucleotides which have 95% identity to polynucleotides having SEQ ID NO: 1 or SEQ ID NO: 5 or to polynucleotides encoding polypeptides of SEQ ID NO: 2 or SEQ ID NO: 6 or to a cDNA contained in an ATCC Deposit. The claims also fail to recite other relevant identifying characteristics (physical and/or chemical and/or functional characteristics coupled with a known or disclosed correlation between function and structure) sufficient to describe the claimed invention in such full, clear, concise and exact terms that a skilled artisan would recognize applicant was in possession of the claimed invention. The specification fails to provide a representative number of species for the claimed genus (those polynucleotides which have 95% identity to polynucleotides having SEQ ID NO: 1 or SEQ ID NO: 5 or to polynucleotides encoding polypeptides of SEQ ID NO: 2 or SEQ ID NO: 6 or to a cDNA contained in an ATCC Deposit). Therefore, the claims are directed to subject matter which was not described in the

Art Unit: 1646

specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Julius et al. publication (P.N.A.S. 87:928-932, Feb. 1990), for example.

Claim 6 is directed to a membrane preparation of a cell transformed or transfected with a polynucleotide of SEQ ID NO: 1 or SEQ ID NO: 5. Applicant is advised that the limitation “of a cell transformed or transfected with” is a product-by-process limitation which does not materially distinguish the claimed membrane preparation from that of Julius et al. A membrane preparation from a cell usually does not contain any DNA at all and certainly does not contain all of the proteins, which are encoded by the nucleic acids present in that cell. The instant claim does not contain any limitations that would require the recombinant DNA recited therein or the polypeptide encoded thereby to actually be present in the membrane. Therefore, this claim encompasses any mammalian cell membrane preparation such as the one that was described in Figure 3 of Julius et al.

Conclusion

9. Claims 1 and 3-6 are rejected. Claims 22, 24-26 and 33 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (703) 305-1003. The examiner can normally be reached on Monday to Friday 9 AM to 5 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 782-9306 for regular communications and (703) 782-9307 for After Final communications.

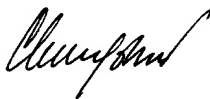
Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556 or (703) 308-4242. If either of these numbers is out of service, please call the Group receptionist for an alternative number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to (703) 308-0294.

Art Unit: 1646

• Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Olga N. Chernyshev, Ph.D.

A handwritten signature in cursive script, appearing to read "Chernyshev", written in black ink.